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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/090,791	Applicant(s) ROE ET AL.	
	Examiner Robert B. Harrell	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005 -et seq.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20051130</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 1-21 remain presented for examination.
2. The Oath and/or Declaration is defective as the date of execution by each of the inventors is/are lacking and thus stand objected. Thus a new Oath and/or Declaration is required in response to this Office Action.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The textual portion of the specification is replete with grammatical and idiomatic errors too numerous to mention specifically. The specification should be revised carefully. For example, on page 3 (lines 21-22), and the Abstract of this application, there is recited "the service packets belonging to a particular service flow carry indication of a corresponding one of said signaling functions" is incomplete for lacking "an" between "carry" and "indication". Also, page 3 (lines 25-32) of the specification recites a source that receives while a sink that transmits which is reverse to the norm in the art in that sources transmit while sinks receive. Thus the Specification stands objected to on these two example matters along with any other textual portion with grammatical and idiomatic errors.
5. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
6. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. **Claims 1-21 are rejected under 35 U.S.C 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:
 - a) "the level"--claim 1 (claim 1) and all other claims 2-21;
 - b) "the first"—claim 2;
 - c) "the second"—claim 2;
 - d) "said two"—claim 6 (lines 1 and 3).
 - e) "the pure Ethernet"—claim 7;
 - f) "said packets"—claim 9 and claim 10 ([*note claim 1 (line 3 "information packet" and lines 4-5 "service packets");

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- g) "the header"—claim 11;
- h) "the data"—claim 11;
- i) "the same"—claim 20;
- j) "A method"—claim 2 (line 1)[*should be "The method*].

8. As to 7 (a-j) above, these are but a few examples of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

9. Claim 1 (lines 5-7), and all other in claims 2-21 such as, but not limited to, claim 13 and claim 21, is indefinite since the claims appears incomplete with the absence of "an" after "carry" in line 6 of claim 1 and the like for the other claims.

10. Per claim 2, and claims with the same limitation(s) such as, but not limited to, claim 13 and claim 18, directed to a source that receives while a sink that transmits is vague as such runs contrary to norm in the art in that sources transmit while sinks receive. Thus it cannot be clearly ascertained if the source actually transmits, as normal in the art, or receives and the like for sink in the reverses.

11. Claim 6, the meets and bounds of this claim cannot be clearly ascertained by the text "and/or"; Isame holds for all claims.

12. Claim 8, the meets and bounds of this claim cannot be clearly ascertained by the text "(s)"; same holds for all claims.

13. Channels are they themselves transmitted per claim 15, and others such as this claim, and thus such text is vague and indefinite. Channels do not get transmitted, they are an established protocol of tangible item.

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14. Per claim 12, and other as such, “non-exhaustive list” is open ended and thus the meets and bounds not established therein the claim.

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

16. **Claims 1-21 rejected under 35 U.S.C. 102 (e)** as being anticipated by Giorgetta et al. (United States Patent Number: US 6,775,799 B1).

17. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant’s attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

18. To the best examiner can understand the claimed invention in light of the above, per claim 1, Giorgetta taught a method of providing a signaling channel (e.g., Abstract) for performing one or more signaling functions at the level of Ethernet (e.g., see Abstract) wherein telecommunication (e.g., see col. 1 (line 11 “Internet” was telephone based (in part)) is organized by information packets forming an information flow (e.g., see figure 6 (202)), the method comprises utilizing a combined flow (e.g., see figure 6 (208 and 216) and col. 10 (line 7-et seq.)) composed from said information flow (e.g., see figure 6 (202)) and one or more service flows (e.g., see figure 6 (205b)) formed from service packets (e.g., see col. 8 (line 64-et seq.)) being compatible with said information packets (“compatible” being herein defined on page 4 (lines 14-15) of this application in paragraph [0020]), wherein the service packets belonging to a particular service flow carry indication of a corresponding one of said signaling functions to be performed, while said one or more service flows form the signaling channel at the level of Ethernet (e.g., see col. 9 (line 60- et seq.)).

19. Per claim 2, the applied reference also taught a method according to claim 1, for providing the signaling channel at the level of Ethernet between a first and a second operating points in a

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network domain (e.g., see figure 1 and note there are many operating points among Internet and SONET), the method comprising steps of: arranging at the first operating point a source element (e.g., see figure 1 and/or figure 3) capable of receiving the information flow from a first Ethernet device (e.g., see Abstract), arranging at the second operating point a sink element capable of transmitting the information flow to a second Ethernet device (e.g., see Abstract and figure 1 and/or figure 3), producing at the source element the service packets forming said one or more service flows (e.g., see figure 6) at the source element, merging said one or more service flows with the information flow (e.g., see figure 6 (216)), thereby obtaining the combined flow with the signaling channel (e.g., see figure 6 (218), transmitting data comprised in the combined flow via the network domain from the source element to the sink element (e.g., see figure 6 (210)), at the sink element, extracting the service packets of said one or more service flows from said combined flow and processing said service packets, thereby performing said one or more signaling functions (e.g., see figure 1 and/or figure 3, and Abstract, and figure 6).

20. Per claim 3, the applied reference also taught the method according to claim 2, wherein the step of producing the service packets forming said one or more service flows is performed at the source element based on at least one of the following two operations: monitoring the information flow and monitoring external instructions per the Abstract "monitoring" and as enumerated in col. 10 (lines 1-6)).

21. Per claim 4, the applied reference also taught the method according to claim 1, wherein said service packets compatible with the information packets are suitable for multiplexing with one another because "compatible" has been defined in this application on page 4 (lines 14-15) in paragraph [0020]; and, since the flows (streams) were interleaved, they were compatible according to the given definition in this application.

22. Per claim 5, claim 6, claim 7, and claim 8 the applied reference also taught the method according to claim 2, further comprising arranging one or more monitoring points between the two operating points since the Internet and SONET, as covered above, was taught and since such type of networks had several nodes (points). Thus the applied reference also taught arranging between said two, basic, operating points at least one additional operating point comprising an additional source element and/or sink element, thereby forming two or more signaling channels between said two basic operating points subdivided into a span of network domain in which one belonged only to Ethernet and the other to only SONET fiber optics where data was preserved during transporting.

23. Per claim 9 and claim 10, the applied reference also taught the method according to claim 1, further comprising at least one step from the following list: mapping packets of the combined flow into frames of a transport network for transmitting said packets via the transport network (e.g., see col. 16 (line 64-et seq.)). The claim 8 calls for "at least one step from". Nonetheless, for claim 10 de-mapping was inherently apart of retrieving the data information from the transmitted packets.

24. Per claim 10, the applied reference also taught the method according to claim 8, further

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comprising the following steps: mapping packets of the combined flow into frames of the transport network for transmitting said packets via the transport network, de-mapping frames of the transport network incorporating said combined flow, for separating thereof from said frames and processing, thereby preserving the signaling channel at the Ethernet level.

25. Per claim 11 and claim 12, the applied reference also taught the method according to claim 1, comprising indication of a particular signaling function in the header of a service packet of said service packets, and providing data on said particular signaling function in the data field of the service packet; wherein said one or more of the signaling functions are selected from the following non-exhaustive list: performance monitoring functions including at least one Tandem Connection function; one way and round trip delay measurement function; far end status function, connection integrity check function, buffer fill check function, function for enabling congestion indication and rate control per col. 10 (lines 1-6) as among trace section message errors, synchronization errors, frame alignment errors, byte alignment errors, B1 and B2 bit errors, bit error rate (BER) calculations, Alarm Indication Signal (AIS) errors, and Remote Error Indicator (REI) errors.

26. Per claims 13-21, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.


27. All arguments presented by the applicant, to date, have been fully considered but deemed moot in view of the new grounds of rejection and new rejections cited above. Therefor, this action is NOT-FINAL.

28. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.


ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142